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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,697	10/20/2003	Kazuo Kaneko	00862.023288.	2836
5514 7590 04/27/2010 FITZPATRICK CELLA HARPER & SCINTO 1290 Avenue of the Americas NEW YORK, NY 10104-3800				
EXAMINER				
PHAM, LINH K				
ART UNIT		PAPER NUMBER		
2174				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/687,697

**Applicant(s)**

KANEKO ET AL.

**Examiner**

LINH K. PHAM

**Art Unit**

2174

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 27-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

**DETAILED ACTION**

1. This communication is responsive to the Amendment filed on 02/12/2010.
2. In the Instant Amendment, Claims 1, 29-30 have been amended; Claims 27, 29-30 are independent claims. Claims 27-30 have been examined and are pending in this application. **This Action is made FINAL.**

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 27 and 29-30 are rejected under 35 U.S.C. 102(b)** as being anticipated by Street, Jr. ("Street", US 7,230,745).

**Regarding claim 27**, Street discloses an information processing apparatus for executing a predetermined procedure corresponding to a command designated by a user, the apparatus comprising:

a database which holds (*Fig. 2; memory 230, which is known as database, contains one more interaction control provider 249, control selection responder 245, and ...*) (i) a plurality of candidates corresponding to a plurality of commands (*Col. 8, lines*

24-57; Fig. 5; a subroutine will prompt the options, which are known as a plurality of commands, to a user; at step 505, where the person is prompted to indicate and the user can presses or says '1' if you don't want to receive this fax, '2' if you want to receive this fax now, '3' for us to hang up and call you back later, '4' if you want to forward this fax to someone else, or '5' if you want us to place this fax on hold) and (ii) command groups, each command group including a plurality of commands related to each other (Col. 8, lines 24-67 to col. 9, lines 1-54; Figs. 5-6; option subroutine 'Play cancel options' 520, 'Play send option' 530, 'Play retry options' 540, 'play forward option' 550, and 'Play hold option' 560 are known as command group, each group includes a plurality of option, at step 605 the control system will prompt a plurality options to user if the user presses 1 or says 1 at step 515; see also Fig. 7-10);

a selection unit which selects (i) a command group from the database, in response to a user operation (Fig. 2; memory 230, contains control selection responder 245, which is will responses to the selected option) and (ii) the candidates from the database that correspond to the plurality of commands in the selected command group (Col. 8, lines 24-67 to col. 9, lines 1-54; Figs. 5-6; the control system 240 will play a subroutine which correspond to the plurality of option in the selected option; also see Fig. 7 is a diagram of 'Play send option subroutine 530; Fig. 8 is a diagram of 'Play retry option subroutine' 540, Fig. 9 is a diagram of 'Play forward option subroutine' 540, and Fig. 10 is a diagram of 'Play hold option subroutine 560);

a voice output unit which receives from the selection unit the selected candidates and outputs each selected candidate one at a time as voice information (abstract; an

*interactive voice response system is used to receive and interpret input from a human recipient, col. 3, lines 3, lines 10-21; the system may detect the presence of the human recipient via speech recognition (e.g., detecting a person answering "hello"), and may provide voice prompts to allow the human recipient to control the fax transmission; also see col.8, lines 24-67 to col. 9, lines 1-54; Figs. 5-10);*

*a decision button which is operable by the user to designate any one of the selected candidates output by the voice output unit (col.8, lines 24-67 to col. 9, lines 1-54; Figs. 5-10; wherein at least steps 505, 605, 630, 705, 805, 920, 945, 1005, and 1030); and*

*a determination unit which determines (i) which one of the candidates is designated by the user (col.8, lines 24-67 to col. 9, lines 1-54; Figs. 5-10; wherein at least steps 520, 605, 615, 620, and 630) and (ii) a command in the database that corresponds to the designated candidate (col.8, lines 24-67 to col. 9, lines 1-54; Figs. 5-10; wherein at least steps 520-699, the system 240 will prompt another option subroutine that corresponds to the selected option by user), wherein, when the user operates the decision button during the voice information corresponding to one candidate that is output by the voice output unit, the determination unit determines a command corresponding to that candidate as the designated command (col.8, lines 24-67 to col. 9, lines 1-54; Figs. 5-10; while the interaction voice prompts the options subroutine, the use can press the number button or say the number which is associated with the option), and when the user operates the decision button during the voice information corresponding to another candidate that is output by the voice output unit, the determination unit*

determines a command corresponding to the other candidate as the designated command (col. 8, lines 65-67 to col. 9, lines 1-28; Fig. 6; wherein at least step 615-630; see also Fig. 7-10).

**Regarding claim 29**, claim 29 is similar in scope to claim 27, and is therefore rejected under similar rationale.

**Regarding claim 30**, claim 30 is similar in scope to claim 29, and is therefore rejected under similar rationale.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. **Claim 28 is rejected under 35 U.S.C. 103(a)** as being unpatentable over Street, Jr. ("Street", US 7,230,745), in view of Epler et al., ("Epler", US 6,026,156).

**Regarding claim 28**, Street discloses the information processing apparatus according to claim 27.

Street does not explicitly disclose if the user operates the decision button between the end of the voice information output of a previous candidate, and the start of the voice information output of a subsequent candidate, the determination unit determines a command corresponding to the previous candidate as the designated command.

However, Epler teaches a system for providing telecommunication services to a user, wherein, if the user operates the decision button between the end of the voice information output of a previous candidate, and the start of the voice information output of a subsequent candidate, the determination unit determines a command corresponding to the previous candidate as the designated command (*col. 10, line 67 to col. 11, lines 1-10; Figs. 4A-4C, at step 212, inactive timeout or disconnect detected, the system will check if the user is still on the line the system control will return to step 208*).

Therefore, it would have been obvious to an artisan at the time invention was made to combine the teachings of Epler with the system of Street, in order to provide users with a means for providing an enhanced call waiting telecommunication service to a user when the user is engaged in a telephone conversation via a telephone switch with a

first party at the same time a second party attempts to place a telephone call to the user  
(*col. 2, lines 5-10*).

### ***Response to Arguments***

8. Applicant's arguments with respect to claim 27-30 have been considered but are moot in view of the new ground(s) of rejection.
9. The specification of the abstract is withdrawn as the abstract has been amended.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



***Inquiries***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LINH K. PHAM whose telephone number is (571)270-3230. The examiner can normally be reached on Monday to Thursday from 7:30AM to 5:00PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doon Y. Chow can be reached on (571) 272-7767. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DENNIS-DOON CHOW/  
Supervisory Patent Examiner, Art Unit 2174

April 14, 2010  
/Linh K Pham/  
Examiner, Art Unit 2174